REMARKS

The Examiner is thanked for the performance of a thorough search. By this amendment, Claims 26-28 are cancelled. New claims 35-38 are added. Hence, Claims 1-25, 29-30 and 32-38 are pending in the Application. It is respectfully submitted that the new claims do not add any new matter to this application.

New claim 35 is supported by the specification on page 1, lines 1-5, and page 20 lines 12-22. New claim 36 is supported by the specification on page 1, lines 1-5, and page 19 lines 1-5. New claim 37 is supported by the specification on page 20, lines 5-8. New claim 38 is supported by specification on page 23, lines 16-19.

SUMMARY OF REJECTIONS/OBJECTIONS

In the Office Action, Claims 1-3, 6-8, 11, 14-18, 24-30 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,959,945 issued to *Kleiman*, hereinafter *Kleiman*.

Claims 1-3, 6-8, 11, 14-18, 24-30 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Official Notice referenced from Paper No. 8, page 3, paragraph no. 6.

Claims 5, 9, 12, 13 and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kleiman as applied to claims 1-3, 6-8, 11, 14-18, and 24-34 above, and further in view of Bernstein

Claims 1-30 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,248,946 issued to *Dwek*, hereinafter *Dwek*.

Claims 1-30 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,442,285 issued to *Rhoads*, hereinafter after *Rhoads*.

Claims 1-30 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,487,145 issued to *Berhan*, hereinafter after *Berhan*.

Claims 1-30 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,931,901 issued to *Wolfe et al.*, hereinafter after *Wolfe*.

The Examiner's Official Notice Does Not Accurately Portray the State of the Art as of July 26 1999

The Examiner rejects claims 1-3, 6-8, 11, 14, 15-18, and 24-34 as being obvious in view of an Official Notice referenced in an office action dated 2 October 2001. In that office action the Examiner contends that IBM PC-compatible computers where widely known and were widely known to be compatible of playing download music from the Internet. The Examiner also took notice that the use of LANs and WANs to connect these machines to the Internet was widely known. From these notices, the Examiner concludes that it would have been obvious to provide a user with entertainment consisting of music through a LAN connected to a WAN using the capability of a personal computer.

The Applicant respectfully traverses the Examiner's conclusion and believes the facts as described by the Examiner do not accurately portray the state of the art as of July 2, 1999. While IBM personal computers capable of playing music and the Internet where well known in July of 1999, the Applicant contends that the providing of a device and method to enjoy a wide variety of music selections at a single location as described in the claims is novel. At the time of the Examiner's Official Notice the Internet was faced with bandwidth challenges that inspired dramatic alterations to WAN and LAN structures. The bandwidth limitation also limited downloading and uploading of digital content such as music. Kleiman identified this need by disclosing in the background section that the cost of transferring large files such as songs can be cost prohibitive for a computerized jukebox using a central music storage location. *See Kleiman* at Col. 3, lines 20-25. While there was a need for a device and method to provide a user with access to a wide selection of entertainment media, no such device or method was available. The Applicant met this need by creating a novel device and method for providing a user a wide selection of entertainment media while minimizing the need for a high bandwidth connection with the Internet via a LAN or WAN. The long sought need and commercial success of the Applicant's design is evidence of the novelty of the Applicant's claimed invention. Correspondingly, the Applicant respectfully requests the rejection based on the Examiner's Official Notice be withdrawn.

REJECTIONS UNDER 35 U.S.C. § 103(a)

Independent Claims 1, 11, 16, and 29

The independent Claims 1, 11, 16, and 29 each contain the limitation that there is a master list of entertainment content that is distinct from a local list of entertainment content. The master list of entertainment content is stored on the WAN, whereas the local list is stored locally on the entertainment unit. In contrast, Kleiman merely discloses one "hierarchy of classes of music with levels of music types...and sub-types..., albums, and songs" (see Column 9, lines 25-27). Thus, the user in Kleiman can select, from this hierarchy, either songs that can be locally accessed (column 9 lines 35-36) or "the user can traverse the hierarchy to select types of music or specific songs which are not currently available" (see column 9, lines 40-43). Thus, Kleiman, fails to disclose or make obvious the limitation of a master list that is distinct from the local list. Moreover, Dwek, Rhoads, Berhan, Wolfe, Sitrick, Shannon, Scibora, Rouchon fail to disclose or make obvious the limitation of a master list that is distinct from the local list. Thus, independent Claims 1, 11, 16, and 29 are allowable over the art.

Claims 2-10, 12-15, 17-25, 30, 32-34

Claims 2-10 and 24 are either directly or indirectly dependent on Claim 1 and include all the limitations of Claim 1, and therefore are allowable for at least the reasons provided herein with respect to Claim 1. Furthermore, it is respectfully submitted that Claims 2-10 and 24 recite additional features that independently render Claims 2-10 and 24 patentable over the art of record.

Claims 12-15 are either directly or indirectly dependent on Claim 11 and include all the limitations of Claim 11, and therefore are allowable for at least the reasons provided herein with respect to Claim 11. Furthermore, it is respectfully submitted that Claims 12-15 recite additional features that independently render Claims 12-15 patentable over the art of record.

Claims 17-23, and 25 are either directly or indirectly dependent on Claim 16 and include all the limitations of Claim 16, and therefore are allowable for at least the reasons provided herein with respect to Claim 16. Furthermore, it is respectfully submitted that Claims 17-23, and 25 recite additional features that independently render Claims 17-23, and 25 patentable over the art of record.

Claims 30, 32-34 are either directly or indirectly dependent on Claim 29 and include all the limitations of Claim 29, and therefore are allowable for at least the reasons provided herein with respect to Claim 29. Furthermore, it is respectfully submitted that Claims 30, 32-34 recite additional features that independently render Claims 30, 32-34 patentable over the art of record.

Dwek:

The Examiner states that "Dwek discloses a multimedia content delivery comprising a master list 110 and a local list 344 that may be accessed via a computer." It is respectfully submitted that the "online music library 110" is a library of software components and thus is not a master list of songs. See column 6, lines 31-38, where the "online music library performs a search of the online music database 114." Thus, the online music library 110 of Dwek is analogous to software mathematical libraries used by software applications used to solve engineering problems, for example.

Even assuming that Dwek discloses a list, there is at most only one list, i.e., a list of selections in the database. "List 344" is not a local list. In fact Dwek describes it as "subpane 344". Thus "subpane 344" is a graphical display pane that shows search results. For example, the user may submit a search query for selections in the database. The results of the user's search would appear in "subpane 344". These search results are referring to content stored in the database (see column 6, lines 9-14, and lines 31-38). Moreover, Dwek only discloses delivery of songs and nothing else.

Rhoads

The Examiner states that "Rhoads discloses a multimedia content, e.g. music delivery comprising a master list and a local list, e.g. col. 8, that may be accessed via a gui computer system on the Internet and stored at a web site and protected by ID."

Column 8 of Rhoads does not disclose lists of any sort. Column 8 merely discloses the manner in which a user may purchase music by using the "re-configurable watermark detector" in Rhoads invention. For example, "[i]f a user hears a song they want to record and keep, they press the Capture button while the song is playing. In response the radio device decodes a watermark embedded in the music, and thereby knows the identity of the music." (Column 8 lines 16-30). Further, Rhoads fails to disclose delivery of any content other than songs.

Berhan

The Examiner states that "Berhan discloses a multimedia content, e.g. music delivery comprising a master list and a local list that may be accessed via a computer system and downloaded over the Internet." However, it is respectfully noted that the Examiner has not pointed to any specific section in Berhan in support of the Examiner's assertions.

Berhan discloses a method for extracting music data from a compact disk and does not in anyway disclose the distribution of electronic entertainment including electronic music, movie and television content, and games for use in out-of-home venues.

Wolfe

The Examiner states that "Wolfe discloses music on demand from the Internet." Wolfe describes a method for delivering a music file to a user. Along with the music file, target advertising is also delivered to the user (see column 3, lines 25-34 and Abstract). Wolfe merely describes delivering a specific music file to the user rather than mass distribution of entertainment content including electronic music and games for use in out-of-home venues. Thus, it is respectfully submitted that Wolfe does not disclose the distribution of electronic entertainment including electronic music and games for use in out-of-home venues.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is encouraged to call the undersigned at (650) 838-4311.

The Commissioner is authorized to charge any fees due to Applicants' Deposit Account No. 50-2207.

Respectfully submitted,
Perkins Coie LLP

Date: June 3, 2003

Carina M. Tan
Registration No. 45,769

Correspondence Address:

Customer No. 22918
Perkins Coie LLP
P. O. Box 2168
Menlo Park, California 94026
(650) 838-4300